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In re Application of :
STRINGER, Andrew Mark :
Application No.: 10/039,565 :
Filing Date: 21 December 2001 : **DECISION**
Attorney Docket No.: 717901.20 :
For: COMPUTER NETWORK PAYMENT :
SYSTEM :

This decision is in response to applicant's "Petition for Correction of National Phase Filing for Status for a Patent Application under 37 C.F.R. Section 1.182" filed on 19 February 2002. The $130.00 petition fee has been paid.

BACKGROUND

On 21 December 2001, applicant filed a transmittal letter for a patent application in the United States which was accompanied by, *inter alia*, a $370.00 utility filing fee. The application was processed as a filing under 35 U.S.C. 111(a).

On 14 February 2002, the United States Patent and Trademark Office mailed "Notice to File Missing Parts of Nonprovisional Application" indicating that the declaration in compliance with 37 CFR 1.63 along with a $65.00 surcharge fee was required.

On 19 February 2002, applicant filed the instant petition to convert.

On 26 February 2002, applicant filed an executed declaration and power of attorney.

DISCUSSION

In the papers filed 19 February 2002, applicant requests to convert the above-captioned application to a U.S. National Phase application of PCT/GB00/02413.

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 (April 14, 1987) entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371, (the National Stage of PCT)" states, in part, that: "[i]f there are any conflicting instructions as to which section of the statute

(371 or 111) is intended the application will be accepted under 35 U.S.C. 111."

A review of the subject application shows that the transmittal letter filed 21 December 2001 did not request treatment under 35 U.S.C. 371. The transmittal letter states that it is "[o]nly for new nonprovisional applications under 37 CFR 1.53(b)." Hence, the application was properly treated as an application under 35 U.S.C. 111 and 37 CFR 1.53.

Nevertheless, applicant requests conversion of the above-identified utility application to a national phase application under 35 U.S.C. 371 and claims:

1. Applicant would be unjustly deprived of national phase status based on a clerical error;

2. Treating as a continuation application is clearly contrary to applicant's intent;

3. Applicant Barred from Obtaining National Phase Status;

4. Person who is dilatory has superior rights; and,

5. Applicant will suffer an undue hardship and prejudice.

These arguments will be considered in turn.

Treatment Unjust

Petitioner claims that applicant would be unjustly deprived of national phase filing status based on a clerical error. This argument has been considered and dismissed. As indicated above, the processing of this application under 35 U.S.C. 111(a) was proper. The transmittal letter alone is sufficient as indicated by the OG Notice and section 1893(a) of the Manual of Patent Examining Procedure.

Applicant also argues that the preliminary amendment was specifically addressed to Box PCT, and that applicant "believes that no bypass continuation patent application has ever been filed at Box PCT, United States Designated/Elected Office (DO/EO/US)." Applicant is mistaken. As indicated in 1077 OG 13 (April 14, 1987), if there are any conflicting instructions the application will be processed under 35 U.S.C. 111(a). The address of the application is irrelevant. Mail directed to the wrong USPTO Box will be redirected to correct box. *See* OG Notice dated 05 February 2002.) While a delay in processing of the misdirected documents may occur, use of the wrong mailing address will not affect the filing date assigned to any application or correspondence received in the PTO, except as specified in 37 CFR 1.1(g). (See OG Notice dated 04 April 1995).

Contrary to Applicant's Intent

Applicant also asserts that the intent of applicant was to file a national stage application. However, applicant intent is not clear and the instructions are conflicting. The submission of a "Utility Patent Application Transmittal Letter is inconsistent with an intent to enter the national stage of the PCT under 35 U.S.C. 371.

Accordingly, the application was properly treated as an application under 35 U.S.C. 111 and 37 CFR 1.53.

Applicant Barred From Filing National Stage

Applicant claims to be barred from obtaining U.S. national phase status because "Applicant will have two pending patent applications that are absolutely identical. Under 35 U.S.C. Sections 101 and 121, this is absolutely and totally prohibited . . . as double patenting."

This claim is erroneous. Applicant is not barred from having two applications only two patents. Therefore, applicant may enter the national phase of PCT/GB00/02413 by including a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. (This recommendation to file a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.)

Dilatory Applicant Has Superior Rights

Applicant claims that "there is no logical reason to allow an applicant, who is absolutely dilatory and does not file anything within the requisite time period set forth by the Patent Cooperation Treaty, to be able to file a petition with a statement that the entire delay was unintentional and easily obtain a U.S. national phase patent application" but deny petitioner "due to the presence of an erroneous transmittal document."

As indicated above, applicant is not barred from having two applications only two patents.

Applicant, Will Suffer Undue Hardship and Prejudice Due to Status

Applicant claims that as a result of his status as a foreign citizen, he will suffer an undue hardship and prejudice by having to provide a certified copy of the underlying British patent No. 9914418.0. In addition, the standard for unity of invention is much more liberal under PCT than under U.S. regulations, which could also provide a hardship to applicant.

These claims are rejected. The requiring of a certified copy of a foreign patent application does not meet this criterion. Moreover, the unity of invention standard for international applications under the PCT is irrelevant to the examination criteria for obtaining a patent in the United States under either 35 U.S.C. 111(a) or 371.

Accordingly, it would not be appropriate to consider the conversion of the application to a national stage application under 35 U.S.C. 371 at this time.

CONCLUSION

Applicant's petition to convert the application from a 35 U.S.C. 111 filing to a national stage application under 35 U.S.C. 371 is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182." No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being returned to the Technology Center 2100 for further examination.

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